UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,066	10/29/2003	Cynthia B. Robinson	02486.0069.NPUS01	9739

21971 7590 07/10/2007
WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO, CA 94304-1050

EXAMINER	
RAMACHANDRAN, UMAMAHESWARI	
ART UNIT	**PAPER NUMBER**
1617	
MAIL DATE	**DELIVERY MODE**
07/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/698,066	ROBINSON ET AL.	
	Examiner	Art Unit	
	Umamaheswari Ramachandran	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicants' election of group I, claims 1-14 without traverse in the reply filed on 3/6/2007 is acknowledged. Applicants' have elected the following species with traverse (received in the office on 5/4/2007). 1) non-glucocorticoid steroids---dehydroepiandrosterone-sulfate (DHEA-S) 2) antihistamine----fexofenadine (Allegra) 3) Ubiquinones--formula (II) claim 6, n=I 0. Claims 1-14 are pending.

Response to Remarks

Applicants' have argued that non-elected species would not require a burdensome search. In response, the instant application contains claims are directed to the following patentably distinct species: the species of non-glucocorticoid steroids; the species of PDE-4 inhibitors; the species of ubiquinones; The species of non-glucocorticoid steroids, PDE-4 inhibitors, and ubiquinones are independent or distinct because they are different chemical compounds with different structures, chemical and physical properties, bioavailabilities, pharmacokinetic profiles, and pharmacological efficacy. Because the species have different structures and properties, different searches are required for each species, which presents a substantial burden to the Office. The restriction requirement is made final.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/923,395. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the pending application teach a pharmaceutical composition comprising the first active agent which is one of non-glucocorticoid steroid and a second active agent which is an anti-histamine. The instant application teaches non-glucocorticoid steroid species encompassed by the genus non-glucocorticoid steroid compounds taught by the co-pending application. The claims (1-14) of the instant application fall within the scope of the claims 1-15 of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nyce (2002/0032160) in view of Kaura et al. (US 2002/0198228).

Nyce teach a composition and various formulations comprising therapeutic amounts of non-glucocorticoid steroid of formula I (para 0018) wherein R1 of formula I is hydrogen or SO2OM, wherein M comprises H, Na, sulfatide etc (para 0019). The reference further teaches that the composition includes the compounds of formula I such as DHEA, analogue thereof or salt thereof such as dihydroepidandrosterone sulfate, and/or a ubiquinone of formula II (elected species) or salt thereof, and a pharmaceutically or veterinarily acceptable carrier or diluent that are useful for treating bronchoconstriction, respiratory tract inflammation, allergies, asthma etc (see Abstract, para 0023, p 7, claim 1, p 8, claims 2-7, 11 and 14, p 9, claim 52). The reference further teaches that the compositions can be administered by generating an aerosol or spray comprised of respirable, inhalable, nasal or intrapulmonary delivered particles ranging from 10 to about 100 u in size (p 8, claims 35, 37, 39). The reference further teaches a kit comprising such formulation and a delivery device, comprising an inhaler wherein the formulation comprises an inhalable, respirable, intrapulmonary or nasal formulation and the inhaler comprises a nebulizer or insufflator that delivers individual premetered doses of the formulation (p 9, claims 42, 43-47).

The reference does not teach a second agent anti-histamine in the composition.

Kaura et al. teach a method and a pharmaceutical composition for the treatment of respiratory disease particularly bronchial asthma, comprising a histamine H1 receptor

antagonist such as fexofenadine (see Abstract, p 3, claims 1, 5, 6, p 4, claims 16-17, 21, 22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add an anti-histamine compound in a composition comprising DHEA and ubiquinone. The motivation to do so is provided by Kaura et al. Kaura et al. teach a pharmaceutical composition comprising a histamine H1 receptor antagonist such as fexofenadine that is useful in the treatment of bronchial asthma. One of ordinary skill in the art would have been motivated to add an anti-histamine compound such as fexofenadine to a composition comprising DHEA and ubiquinone in the treatment of a respiratory condition such as asthma because prior art teaches both the compositions to be useful in the treatment of asthma and one can expect success in achieving a pharmaceutical composition comprising a non-glucocorticoid steroid, DHEA sulfate and fexofenadine and further can expect additive or synergistic effects in the combination therapy of asthma. The examiner respectfully points out the following from MPEP 2144.06: "It is **prima facie obvious** to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose....[T]he idea of combining them flows logically from their, having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069,-1072 (CCPA 1980).

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nyce (2005/0070487, effective filing date, Apr 24 2001) in view of in view of Kaura et al. (US 2002/0198228).

Nyce teach a pharmaceutical or veterinary composition, comprising a first active agent selected from a non-glucocorticoid steroid or analogues, ubiquinone of formula II (elected species), or salts thereof, and a second active agent comprising a bronchodilator that are useful in the prophylaxis and treatment of respiratory, lung and malignant diseases (See Abstract, p 10, para 0049, p 11, formula II). The reference further teach the composition includes the non-glucocorticoid steroid or analogues of formula I, where the H at position 5 is present in the alpha or beta configuration and R1 is H or SO2OM, where M is selected from H, Na, sulfatide etc (para 0035, 0036) that include DHEA and DHEA salts such as DHEA sulfate (para 0045). The reference further teaches the composition comprises a second active agent such as an anti-histamine (p 22, claim 18). The reference teaches a nasal, inhalable, respirable, intrapulmonary or intratracheal formulation of the composition which is an aerosol or spray comprising liquid or solid powdered particle and the inhalable or respirable formulation of claim comprising particles of about 0.05 to about 10 uM in size, the intrapulmonary or intratracheal formulation comprising particles about 10 to about 100 uM in size (p 22, claims 42-46). The reference also teaches a kit comprising a delivery device, and the formulation as above wherein the delivery device comprises an aerosol or spray generator and the aerosol generator comprises an inhaler comprising a nebulizer or insufflator that delivers individual premetered doses of the formulation (p 23, claims 50-54).

The reference does not teach the elected species, fexofenadine as the anti-histamine agent.

Kaura et al. teach a method and a pharmaceutical composition for the treatment of respiratory disease particularly bronchial asthma, comprising a histamine H1 receptor antagonist such as fexofenadine (see Abstract, p 3, claims 1, 5, 6, p 4, claims 16-17, 21, 22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add fexofenadine as an anti-histamine compound in a composition comprising DHEA and ubiquinone. The motivation to do so is provided by Kaura et al. Kaura et al. teach a pharmaceutical composition comprising a histamine H1 receptor antagonist such as fexofenadine that is useful in the treatment of bronchial asthma. One of ordinary skill in the art would have been motivated to add an anti-histamine compound such as fexofenadine to a composition comprising DHEA and ubiquinone in the treatment of a respiratory condition such as asthma because Kaura et al teaches fexofenadine in a pharmaceutical composition and Nyce teach a composition comprising the steroid, ubiquinone and an anti-histamine agent, useful in the treatment of asthma. It would have been obvious to one of ordinary skill in the art at the time of the invention to add in the composition one anti-histamine for another as both are used for the same purpose. One of ordinary skill in the art at the time of the invention would have expected to achieve similar success in formulating a composition comprising a non-glucocorticoid steroid, DHEA sulfate and fexofenadine in the treatment of respiratory disorders such as asthma.

Conclusion

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umamaheswari Ramachandran whose telephone number is 571-272-9926. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER